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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER KASSAN

Appeal 2008-002078
Application 10/671,194
Technology Center 3600

Decided: April 28, 2010

19 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
20 MOHANTY, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Peter Kassan (Appellant) seeks review under 35 U.S.C. § 134 (2002) of
3 a final rejection of claims 1-27 and 29-52, the only claims pending in the
4 application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 SUMMARY OF DECISION¹

8 We AFFIRM.

9 THE INVENTION

10 The Appellant invented a way of reproducing Internet web site content
11 on printed media (Specification 1:¶ 0002).

12 An understanding of the invention can be derived from a reading of
13 exemplary claim 1, which is reproduced below [bracketed matter and some
14 paragraphing added].

15 1. A method for providing printed pages of web hosted
16 information in response to an electronic request received over a
17 communication network, the method comprising:
18 [1] providing add-in software operable with a web site,
19 the add-in software enabling
20 a visitor of the web site

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.", filed May 14, 2007) and Reply Brief ("Reply Br.", filed October 1, 2007), and the Examiner's Answer ("Ans.", mailed July 31, 2007).

1 to submit a request
2 for receiving a printed copy of web hosted information
3 that is displayable as web pages;
4 [2] receiving electronic order information representing the
5 request;
6 [3] processing the electronic order information
7 to provide electronic production information
8 representing instructions for fulfilling the request;
9 [4] transmitting the electronic production information to a
10 fulfillment facility;
11 and
12 [5] providing to the visitor
13 the requested web hosted information from the
14 fulfillment facility in the form of printed pages.

15 THE REJECTIONS

16 The Examiner relies upon the following prior art:

Freedman	US 4,839,829	Jun. 13, 1989
Fischer	US 2002/0010638 A1	Jan. 24, 2002
Arledge	US 6,535,294 B1	Mar. 18, 2003
Ximenes	US 2003/0069811 A1	Apr. 10, 2003
Mulvey	US 2003/0208718 A1	Nov. 6, 2003

17 Examiner cited References from PTO form 892, mailed May 23, 2006:

18 Libby Estell. *Mixed Media*. Incentive, Vol. 176, Iss. 11; p.17. Nov.
19 2002,
20 [http://proquest.umi.com/pqdweb?did=236548131&sid=7&Fmt=4&cli](http://proquest.umi.com/pqdweb?did=236548131&sid=7&Fmt=4&clie)
21 entId=19649&RQT=309&VName=PQD. (Heretofore Reference U).

1 Robert C. Higgins. *Analysis for Financial Management*, Sixth edition.
2 The McGraw-Hill Companies, Inc. 2001. (Heretofore Reference V).

3 Samantha Oller. *Faster finishing for quick printers*. American Printer.
4 Vol. 227, Iss. 5; p. 28-32. Aug 2001.
5 <http://proquest.umi.com/pqdweb?did=79130192&sid=2&Fmt=4&clie>
6 ntld=19649&RQT=309&VName=PQD. (Heretofore Reference X).

7 *Snapfish*.
8 <http://web.archive.org/web/20021115080630/http://www.snapfish.com>.
9 (last visited Nov 15, 2002). (Heretofore Reference UU)

10 Nancy Rouse. *How to get the most out of reprints*. Folio: The Magazine
11 for Magazine Management. Vol. 24, Iss. 19; p. 232.
12 <http://proquest.umi.com/pqdweb?did=7750920&sid=4&Fmt=3&clien>
13 tld=19649&RQT=309&VName=PQD. (Heretofore Reference VV). 1996

14 Claims 1, 2, 8, 12, 13, 15, 18-20, 23, 24, 29, 40, 44, 46, 47, 50, and 51
15 stand rejected under 35 U.S.C. § 102(e) as anticipated by Ximenes.

16 Claims 3-6, 41-43, and 45 stand rejected under 35 U.S.C. § 103(a) as
17 unpatentable over Ximenes and Freedman.

18 Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over
19 Ximenes and reference X.

20 Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable
21 over Ximenes and Mulvey.

22 Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over
23 Ximenes, Mulvey, and Fischer.

24 Claim 14 stands rejected under 35 U.S.C. § 103(a) as unpatentable over
25 Ximenes and reference UU.

26 Claims 16, 17, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as
27 unpatentable over Ximenes and reference VV.

1 Claims 21, 22, and 30-39 stand rejected under 35 U.S.C. § 103(a) as
2 unpatentable over Ximenes and Arledge, Jr.

3 Claims 27, 48, and 49 stand rejected under 35 U.S.C. § 103(a) as
4 unpatentable over Ximenes and reference UU.

5 Claim 52 stands rejected under 35 U.S.C. § 103(a) as unpatentable over
6 Ximenes and reference VV.

7

ARGUMENT

9 The only claims argued are independent claims 1 and 29, which are
10 argued together. Thus the remaining claims stand or fall with those claims.
11 The Appellant argues that Ximenes fails to disclose printing web hosted
12 information displayable as web pages. Appeal Br. 7; *see also* Reply Br. 2.

13

ISSUE

15 The sole issue in this appeal is whether Ximenes describes software
16 enabling a visitor of the web site to submit a request for receiving a printed
17 copy of web hosted information that is displayable as web pages and
18 providing requested web hosted information in the form of printed pages.
19 (claim 1; Limitations [1] & [5]).

20

FACTS PERTINENT TO THE ISSUES

22 The following enumerated Findings of Fact (FF) are believed to be
23 supported by a preponderance of the evidence.

1 *Facts Related to the Prior Art - Ximenes*

2 01. Ximenes is directed to on-demand, high quality reproduction of
3 visual images selected from a computer-accessible library of
4 visual images. Ximenes ¶ 0001.

5 02. Ximenes uses a catalog server and ordering server, in
6 communication with ordering portals and in communication with
7 one or more print facilities. Users search available images and
8 order a reproduction including a reproduction format. The user
9 does this over computer networks such as the internet and the
10 order server can communicate with the print facility in similar
11 manner. Ximenes ¶ 0007.

12 03. The on-demand reproduction of visual images afforded by
13 Ximenes enables reproductions in a wide range of formats. A
14 single print file can accommodate a range of sizes for the
15 reproduction and reproductions on a variety of substrates. Various
16 other format choices are also available, including, for example,
17 aspect ratio (if the visual image is amenable to changing aspect
18 ratio), post reproduction treatments (e.g., canvas stretching,
19 framing options), colors (e.g., a reproduction of an exotic car can
20 be produced in a variety of colors). Ximenes ¶ 0043.

21 04. An order specifying the information required to produce the
22 desired reproduction can be transmitted from the portal using a
23 local or centralized catalog server. An order server accepts the
24 order information and transmits to a print facility where the order
25 is printed. The print file associated with the order can be

transmitted to the print facility, or can be stored at the print facility. Ximenes ¶ 0045.

PRINCIPLES OF LAW

4 *Anticipation*

5 "A claim is anticipated only if each and every element as set forth in the
6 claim is found, either expressly or inherently described, in a single prior art
7 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
8 631 (Fed. Cir. 1987). "When a claim covers several structures or
9 compositions, either generically or as alternatives, the claim is deemed
10 anticipated if any of the structures or compositions within the scope of the
11 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
12 Cir. 2001). "The identical invention must be shown in as complete detail as
13 is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
14 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
15 the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology
16 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

ANALYSIS

18 The two claims argued recite enabling a visitor of the web site to submit
19 a request for receiving a printed copy of web hosted information that is
20 displayable as web pages. The remaining limitations are conventional order
21 processing and fulfillment elements and there is no contention regarding
22 whether Ximenes describes those.

1 The Appellant argues that Ximenes fails to disclose printing web hosted
2 information displayable as web pages. Appeal Br. 7; also Reply Br. 2. The
3 Appellant elaborates on this that

4 the individual visual images displayed on Ximenes' catalog that
5 are available for reproduction are not web hosted information
6 displayable as web pages as required by claims 1 and 29. They
7 are merely images displayed on a web page via the internet.

8 Appeal Br. 9. The Examiner found that in Ximenes,

9 the catalog/library is hosted on the web, displayed to a user via
10 a webpage through the web browser, and is printed at the print
11 facility as a result of a purchase order by a user

12 Ans. 22. We see that the Appellant and the Examiner are interpreting
13 the scope of claim limitation [1] differently. So the issue appears to be that
14 of the scope of limitation [1] of claim 1. To determine this, we must first
15 construe this limitation.

16 Claim 1 limitation [1] recites

17 providing add-in software operable with a web site,
18 the add-in software enabling
19 a visitor of the web site
20 to submit a request
21 for receiving a printed copy of web hosted information
22 that is displayable as web pages;

23 The first thing to note is that this limitation is to software that enables a
24 visitor to submit a request, which there is no argument that Ximenes has.
25 The request is to receive a printed copy. Again, there is no contention as to
26 Ximenes anticipating this.

1 The issue is what the printed copy is to be. The next phrase is “web
2 hosted information.” Clearly Ximenes prints copies of information that its
3 web system hosts. That is to say, a customer sends an order for a print of a
4 visual image found on a catalogue server web site. FF 02 - 04.

5 So now we come to the critical phrase “that is displayable as web
6 pages.” The Appellant argues that this phrase modifies the printed copy,
7 whereas the Examiner found that this phrase modified web hosted
8 information. Perhaps more accurately, that Appellant argues that the phrase
9 “that is displayable as web pages” modifies the manner in which the copy of
10 web hosted information is printed.

11 Since the phrase “web hosted information” is closest to the displayable
12 limitation at issue, we agree that web hosted information is being modified.
13 Although the manner in which each of the phrases “of web hosted
14 information” and “that is displayable as web pages” can be interpreted a
15 number of different ways to modify the phrase “receiving a printed copy,”
16 this is the simplest and straightest forward and therefore what would be the
17 plain meaning of the entire phrase. During examination of a patent
18 application, pending claims are given their broadest reasonable construction
19 consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05
20 (CCPA 1969). *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed.
21 Cir. 2004).

22 So the scope of limitation [1] is any add-in software that enables one to
23 request a printed copy of an image that is displayable, as evidenced by being
24 displayed, on a web page. We note that limitation [5], which requires that

1 the request be carried out, simply requires that the web hosted information
2 be printed, which Ximenes does. FF 04.

3 No other claims were argued, and so the rejections of the remaining
4 claims stand with those of claims 1 and 29.

5

6 CONCLUSIONS OF LAW

7 The Examiner did not err in rejecting claims 1, 2, 8, 12, 13, 15, 18-20,
8 23, 24, 29, 40, 44, 46, 47, 50, and 51 under 35 U.S.C. § 102(e) as anticipated
9 by Ximenes.

10 The Examiner did not err in rejecting claims 3-6, 41-43, and 45 under
11 35 U.S.C. § 103(a) as unpatentable over Ximenes and Freedman.

12 The Examiner did not err in rejecting claim 7 under 35 U.S.C. § 103(a)
13 as unpatentable over Ximenes and reference X.

14 The Examiner did not err in rejecting claims 9 and 10 under 35 U.S.C.
15 § 103(a) as unpatentable over Ximenes and Mulvey.

16 The Examiner did not err in rejecting claim 11 under 35 U.S.C. § 103(a)
17 as unpatentable over Ximenes, Mulvey, and Fischer.

18 The Examiner did not err in rejecting claim 14 under 35 U.S.C. § 103(a)
19 as unpatentable over Ximenes and reference U.

20 The Examiner did not err in rejecting claims 16, 17, 25, and 26 under
21 35 U.S.C. § 103(a) as unpatentable over Ximenes and reference V.

22 The Examiner did not err in rejecting claims 21, 22, and 30-39 under
23 35 U.S.C. § 103(a) as unpatentable over Ximenes and Arledge.

1 The Examiner did not err in rejecting claims 27, 48, and 49 under
2 35 U.S.C. § 103(a) as unpatentable over Ximenes and reference UU.

3 The Examiner did not err in rejecting claim 52 under 35 U.S.C. § 103(a)
4 as unpatentable over Ximenes and reference VV.

5

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1, 2, 8, 12, 13, 15, 18-20, 23, 24, 29, 40, 44, 46, 47, 50, and 51 under 35 U.S.C. § 102(e) as anticipated by Ximenes is sustained.
- The rejection of claims 3-6, 41-43, and 45 under 35 U.S.C. § 103(a) as unpatentable over Ximenes and Freedman is sustained.
- The rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Ximenes and reference X is sustained.
- The rejection of claims 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over Ximenes and Mulvey is sustained.
- The rejection of claim 11 under 35 U.S.C. § 103(a) as unpatentable over Ximenes, Mulvey, and Fischer is sustained.
- The rejection of claim 14 under 35 U.S.C. § 103(a) as unpatentable over Ximenes and reference UU is sustained.
- The rejection of claims 16, 17, 25, and 26 under 35 U.S.C. § 103(a) as unpatentable over Ximenes and reference VV is sustained.

- 1 • The rejection of claims 21, 22, and 30-39 under 35 U.S.C. § 103(a) as
2 unpatentable over Ximenes and Arledge is sustained.
- 3 • The rejection of claims 27, 48, and 49 under 35 U.S.C. § 103(a) as
4 unpatentable over Ximenes and reference UU is sustained.
- 5 • The rejection of claim 52 under 35 U.S.C. § 103(a) as unpatentable
6 over Ximenes and reference VV is sustained.

7 No time period for taking any subsequent action in connection with this
8 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

9

10 AFFIRMED

11

12

13

14 mev

15

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